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09/899,260	07/06/2001	Toshikazu Higashi	018656-234	3456

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EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3692

MAIL DATE	DELIVERY MODE
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01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/899,260

Applicant(s)

HIGASHI ET AL.

Examiner

Jennifer Liversedge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/899,260 filed on October 31, 2007.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

Claim Objections

Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 7 appears to have elements of both an independent claim and a claim dependent on claim 5.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-5 and 8 refer to "...receiving...data including both processing data...and an amount of electronic money that is necessary for payment..." and subsequently "...wherein the processing data and the electronic money are attached together..." as well as further reference to the received electronic money. The use of the phrases "an amount of electronic money" and "the electronic money" and "the received electronic money" are inconsistent by their usage within the claim. The initial reference is to an amount of money. The subsequent references are to electronic money. The differences between the meaning of "an amount of money" and "electronic money" render the claim indefinite. It is unclear from the claim language whether an amount of electronic money is attached together with processing data or whether electronic money is attached together with processing data.

Claims 1-5 and 8 recite the limitation "the electronic money" and "the received electronic money" in multiple locations throughout the claims. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-5 and 8-14 claim that the processing data and the electronic money are attached together. It is unclear how the electronic data and electronic money are attached, and what is meant by the term attached within the context of an electronic transmission of data.

Claim 3 is unclear with regards to steps of receiving data to be information-processed attached together with an amount of electronic money, and then the subsequent step of associating the data with the electronic money. It is unclear what additional elements are intended with the associating step given that the data was previously received as attached together.

Claim 7 appears to be an independent claim, however, it incorporates language referencing claim 5, which renders the claim indefinite as it is unclear whether the claim is intended to further limit claim 5, or whether the claim is intended to stand in independent form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 7,075,666 B1 to Aiyama (further referred to as Aiyama), and further in view of US Patent 6,938,154 B1 to Berson et al. (further referred to as Berson).

Regarding claim 1, Aiyama discloses an information processing and electronic payment method (columns 1-8) comprising the steps of:

Receiving, through a network, data including both processing data to be information-processed and an amount of electronic money that is necessary for payment for information processing of said processing data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7);

Making a request to determine whether the received electronic money is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

When the received electronic money is confirmed to be valid, automatically starting the processing of the processing data to be information-processed (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the processing data and the electronic money are attached together. However, Berson discloses wherein the processing data and the electronic money are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6,

lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 2, Aiyama discloses an information processing method (columns 1-8) comprising the steps of:

Receiving, through a network, data to be information-processed and an amount of electronic money that is necessary for payment for information processing of said processing data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7);

Relating the received data to be information-processed with the electronic money by which payment for information is made (Figure 4; column 6, lines 10-39; column 7, lines 1-8; column 8, lines 6-7);

Making a request to determine whether the received electronic money is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

When the received electronic money is confirmed to be valid, automatically starting the processing of the processing data to be information-processed (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 3, Aiyama discloses an electronic payment method (columns 1-8) comprising the steps of:

Receiving, through a network, data to be information-processed and an amount of electronic money that is necessary for payment for information processing of said processing data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7);

Associating the data with the electronic money (Figure 4; column 6, lines 10-39; column 7, lines 1-5; column 8, lines 6-7);

Making a request to determine whether the received electronic money is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

When the received electronic money is confirmed to be valid, automatically starting the processing of the processing data which is associated with the validated electronic money (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is

processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 4, Aiyama discloses a system for making payment by electronic money (columns 1-8) comprising:

A user side subsystem including a user's terminal (Figures 1 and 4),

An electronic money issuer side subsystem including an electronic money issuing server (Figure 4), and

A processor side subsystem including a data processor that performs a processing based on processing request data from the user (Figures 1 and 4),

Wherein the user side subsystem, the electronic money issuer side subsystem and the processor side subsystem are connected to one another through a network (Figure 4),

Wherein the user side subsystem transmits both the processing request data and electronic money data including an amount of electronic money issued by the electronic money issuer side subsystem that is necessary for payment for processing of the

processing request data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7);

The processor side subsystem transmits the electronic money data to the electronic money issuer side subsystem (column 6, lines 10-67; column 7, lines 1-5; column 8, lines 6-7);

The electronic money issuer side system determines whether the electronic money is valid or not (column 7, lines 1-5; column 8, lines 6-7); and

The processor side subsystem performs the processing based on the processing request data in accordance with a result of the electronic money validation and transmits a request for payment for the processing to the electronic money issuer side subsystem (column 6, lines 10-67; column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would

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be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claims 5-6, Aiyama discloses an electronic money processor (columns 1-8) comprising:

A receiving member which receives both processing request data transmitted from a user through a network and based on which a processing requested by the user is executed and electronic money data transmitted from the user through the network and including an amount of electronic money that is necessary for payment for processing said processing request data and issued by an electronic money issuer (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7);

A memory in which the processing request data received by the receiving member is stored (Figure 1; column 3, lines 52-61);

A transmitter which transmits the electronic money data received by the receiving member to the electronic money issuer to check whether the electronic money is valid or not (Figure 4; column 6, lines 10-67; column 7, lines 1-5; column 8, lines 6-7); and

An execution controller which controls execution of the processing based on the processing request data corresponding to the electronic money data and stored in the

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memory in accordance with a result of the check of validity of the electronic money (column 7, lines 1-16; column 8, lines 6-7).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money are attached together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claim 7, Aiyama discloses an image forming apparatus comprising the electronic money processor as claimed in claim 5 (see rejection to claim 5 above), further comprising:

An image forming portion in which execution of the processing based on the processing request data is controlled by the execution control means of the electronic money processor (column 7, lines 1-16).

Regarding claim 8, Aiyama discloses an image forming apparatus comprising:

A receiving member which receives both print data transmitted from a user through a network and electronic money data corresponding to the print data transmitted from the user through the network and including an amount of electronic money issued by an electronic money issuer that is necessary for payment for processing said print data (Figure 1; column 3, lines 52-61; column 6, lines 10-39; column 8, lines 6-7);

A transmitter which transmits the electronic money data received by the receiving member to the electronic money issuer to check whether the electronic money is valid or not (Figure 4; column 6, lines 10-67; column 7, lines 1-5; column 8, lines 6-7); and

An image forming portion which processes the print data in accordance with a result of the check of validity of the electronic money (column 7, lines 1-16).

Aiyama does not specifically disclose wherein the data to be information-processed and the electronic money are attached together. However, Berson discloses wherein the data to be information-processed and the electronic money are attached

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together (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header; column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Regarding claims 9-14, Aiyama does not specifically disclose wherein the processing data and electronic money are attached together in a data packet including header information and print control command. However, Berson discloses wherein the data to be information-processed and the electronic money are attached together in a data packet including header information and print control command (column 6, lines 54-60 where digital cash along with a document are sent over a network for services; column 1, lines 45-51 where encrypted data are inserted into a packet in a header;

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column 2, lines 32-60 and column 4, lines 28-49 where the encrypted digital certificate is used to enforce usage policies and command for operation of the network device; column 6, lines 54-60 where the usage policies include payment of print services where the time a document is sent and the time it is processed is decoupled in order to process the encrypted documents in between for payment by digital cash which was sent with the document over the network). It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of attaching the processing data and electronic money in a data packet including header information and print control command as disclosed by Berson with the mechanism of accepting electronic money for information processing as disclosed by Aiyama. The motivation would be to associate the information to be processed and the electronic money to pay for it in an encrypted packet for association through the process of sending, paying and printing.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

However, Examiner comments that the main point of argument in the submitted amendment related to the element wherein both data to be information processed and an amount of electronic money that is necessary for payment for the processing of that data are attached together and received via a network, and the argument that this is not disclosed by the provided prior art as provided by the examiner in the office action, is disclosed within the specification in the Description of the Related Art as provided in the

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present application (page 3 within paragraph 6 and page 3 paragraph 8). The applicant has admitted that this element is prior art and known in the field.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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KAMBIZ ABDI
SUPERVISORY PATENT EXAMINER